

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and the following remarks.

Claims 1-21 were pending in this application. By this Amendment, claims 1, 4, 7-9, 13, and 19 are amended, claims 3, 6, 10-12, and 16-18 are canceled, and no claims are added. No new matter has been added. Accordingly, claims 1, 2, 4, 5, 7-9, 13-15, and 19-21 will be pending herein upon entry of this Amendment. For the reasons stated below, Applicant respectfully submits that all claims pending in this application are in condition for allowance.

In the Office Action mailed January 7, 2009, the drawings were objected to as not showing every feature of the claims; claims 1, 3, 4, 8-11, 16, and 17 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite; claims 1-4, 6-12, and 16-18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,469,099 to McEwen ("McEwen"); claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McEwen in view of U.S. Patent No. 4,984,579 to Burgert et al. ("Burgert"); claims 10 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McEwen in view of U.S. Patent No. 5,755,669 to Ono et al. ("Ono"); claims 11, 12, 17, and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McEwen and Ono and further in view of U.S. Patent No. 5,458,571 to Lampropoulos et al. ("Lampropoulos"); and claims 13-15 and 19-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McEwen, Ono, and Lampropoulos in further view of U.S. Patent No. 4,831,242 to Englehardt et al. ("Englehardt"). To the extent that these rejections might still be applied to the claims currently pending in this application, they are respectfully traversed.

Drawing Objections

With regard to the drawing objections, Applicants respectfully submit that the originally filed drawings do in fact show separable first and third input means. Figure 19 of the present application clearly discloses a remote controller RC with a connecting part 120 and terminal 121. The terminal 121 is configured to be removably connected to the remote controller connector 58A shown in Figure 5A, which also shows the first input means on the operation section 58. Accordingly, the drawings show all of the features of the claims. Further explanation is provided, for example, on page 24, line 27, through page 5, line 16, of the present specification. As a result, no amendments to the drawings are believed to be necessary and withdrawal of the objection is respectfully requested.

Rejections Under 35 U.S.C. § 112

With regard to the rejections under 35 U.S.C. § 112, second paragraph, Applicant respectfully submits that the terms “critical” and “maximum” is not relative terms that render the claims indefinite. In the context of the claims, the critical compression pressure or critical compression duration refers to a value determined as “critical” for ensuring safety of the user. In the context of claims 11 and 17, a maximum value is a fixed value that is recorded for the compression pressure or the time interval, upon which the pressure supplied by the compression pressure control unit is based, which is claimed as not to exceed the critical pressure or interval. These terms are not relative. Further explanation of the terms can be found in the specification, for example at page 34, line 22, through page 36, line 10. The terms have their ordinary meaning, which to simply say that “critical” imparts, for example, an upper limit with regard to safety and “maximum” imparts, for example, an upper limit that is governed by the controller or

control unit. The meanings of the terms are not dependent upon another value or reference and they are therefore not relative terms. One of ordinary skill in the art would be completely apprised of the scope of the invention. An example of a relative term would be "a large value," since such a term would be meaningless without a reference frame or value. The terms "maximum value" or "critical value" on the other hand, have specific meanings in the context of the present claims and are not indefinite.

Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph, are respectfully requested.

Rejections Under §§ 102 And 103

With regard to the rejections under §§ 102 and 103, Applicant respectfully submits that the cited references do not disclose the amended claims. Without prejudice to or disclaimer of the subject matter of the original claims, each of the independent claims 1, 4, and 7-9 has been amended, in order to advance the prosecution of this application, to include the subject matter of claims 10-12 or 16-18. Accordingly, Applicant will direct the following remarks to the Examiner's rationale in support of original claims 12 and 18, since all currently pending claims now include those features. Further explanation of possible benefits of these features can be found in the specification, for example at page 33, line 20, through page 34, line 19. The use of the terms "third" and "fourth" have been replaced with "first" and "second," respectively, for clarity. The terms "first" and "second" are not intended to specify any particular device or import any particular characteristics from the specification but are merely indicia used to denote a particular one of several claimed components within the context of the claim.

Applicant respectfully submits that the Examiner's purported obviousness rationale in support of the rejection of original claims 12 and 18, found on page 16-17 of the Office Action, is in error. The Examiner appears to present two distinct obviousness arguments in support of the rejections: (i) in the second paragraph of page 16, of the Office Action, the Examiner applies case law for the proposition that it would be obvious to separate formerly integral structure in various elements, and (ii) in the third paragraph of page 16, the Examiner seems to apply a conclusory statement of obviousness, when no cited references actually disclose the claimed features to arrive at the claimed invention, using rationale solely divined from Applicant's present application. Each of these arguments will be addressed in turn.

Preliminarily, Applicant notes that the claim feature at issue relates to the separability of a first input means, claimed to input a critical compression value (pressure or duration), from a second input means, claimed to input a maximum compression value (pressure or duration). An exemplary embodiment disclosed in the specification is the remote controller RC as the first input means and the operation section 58 as including the second means. (*See, e.g.*, page 33, line 20, through page 34, line 19.) A disclosed benefit is that the first input means may be only used by a person who has significant knowledge about the pressure muscle training method, *e.g.*, a trainer or a physician, preventing the user from setting the maximum value of the compression pressure and the compression duration that are used in practicing the pressure muscle training method beyond the critical compression pressure and the critical compression duration. This ensures high safety of the pressure muscle training method.

Exemplary features of the claimed invention can be summarized with respect to three aspects as follows:

- the first input means is outside the main body, which main body has the second input means;
- data input from the first input means is a critical compression value (pressure or duration); and
- the second input means on the main body sets the maximum value of the compression values (pressure or duration) that are used in practicing the pressure muscle training method to the extent equal to or lower than the critical compression value (pressure or duration).

These three features contribute to possible advantageous effects of the present invention in that the user can set the *maximum* value of the compression pressure or duration depending on his/her physical condition with high safety of the pressure muscle training method while being limited by the *critical* compression pressure or duration set by the trainer. This achieves both freedom and safety of the pressure muscle training method in a manner not contemplated by the prior art.

With regard to the Examiner's first argument, that it would be obvious to separate formerly integral elements, the argument fails immediately because the cited references do not disclose such a "formerly integral" device that is to be separated. That is, the present invention includes a first input means and a second input means. The cited references only disclose a single input means which, if separated from the machine main body, would still result in a total of one input means and no input means on the main body. Further, Applicant has demonstrated that the claimed features are critical, in that the separability of the first input means provides

distinct advantages, including safety, over the cited references. For this reason, the Examiner's use of legal precedent is inapt:

if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. Examples directed to various common practices which the court has held normally require only ordinary skill in the art and hence are considered routine expedients are discussed below. If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.

MPEP § 2144.04. Further, the facts in the cited decision are not sufficiently similar to those in the present application, further supporting the inapplicability of the case law.

The Examiner's second obviousness argument fails to provide a *prima facie* showing of obviousness on its face. Firstly, the Examiner fails to identify where the claimed features are shown in the cited references and attempts to bridge the gap with speculation of beneficial results and what one of skill in the art would have been motivated to recognize. Secondly, the Examiner further attempts to bridge these gaps using rationale divined solely from the present application. The cited references deal in large part with pneumatic cuffs for use during medical procedures or for blood pressure testing and are not concerned with muscle development, as in the present invention. The Examiner extracts the benefits solely by virtue of being provided with the present specification, not the prior art, and thereby constructs an improper obviousness rationale using conclusory statements. "[R]ejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006); MPEP § 2142 *et seq.*

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To the extent that the Examiner seeks to rely on Official Notice, Applicant directs the Examiner's attention to the proper procedure for doing so as laid out in MPEP § 2144.03. To the extent that the Examiner maintains that a proper taking of Official Notice has been set forth, Applicant respectfully traverses such Notice and requests that the Examiner provide sufficient documentary evidence in response. Applicant incorporates the above arguments as reasons for traversing the Notice on the basis that such facts would not be considered common knowledge or well-known in the art.

In view of the foregoing all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative at the number listed below.

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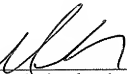
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